

### **REMARKS**

Claims 1-27 and 30-45 are rejected in the Office Action. Claims 1 and 20 are amended with this reply. Claims 30-45 are amended to renumber them from claim 28-43. Upon entry of the amendments, claims 1-43 remain pending.

Support for the amended claims is found in the specification as originally filed. Claim 1 is amended to clarify that the “first fibers” is a first set of fibers and that the “second fibers” is a second set of fibers. The phrases are added for purpose of clarity and are not new matter. Likewise, the amendment to claim 20 clarifies that the reinforcing fiber component is mixed with the resin component and does not add new matter. Applicants respectfully request entry of the amendments.

### **MISSING CLAIMS 28 AND 29**

Claims 28 and 29 are not missing in the Application, but claims 30-45 are numbered in error. To rectify the situation, Applicants have amended claims 30-45 as claims 28-43, respectively. Rejection of the original claims 30-45 will be discussed below, maintaining reference to the original claim numbers for clarity.

### **DOUBLE PATENTING OVER CO-PENDING APPLICATION 10/601,250**

Claims 11, 15, 20, 30-34, and 45 are provisionally rejected as claiming the same invention as claims 1-7, 10, 35, and 37 of co-pending Application 10/601,250 (Docket No. H-205868, 8540R-000002). The rejection is provisional because the conflicting claims have not in fact been patented. For this reason, Applicants respectfully submit no action is needed in order to make a fully responsive reply.

Notwithstanding, Applicants would like to point out that the cited claims of the co-pending Application (the “co-pending claims”) do not in fact claim the same invention as the rejected claims 11, 15, 20, 30-34, and 45 (the “pending claims”). For example, co-pending claims 1-7 are drawn to a method of preparing a composite by spray of operations as are pending claims 30-34. However, the co-pending claims recite many limitations not found in the pending claims and *vice versa*. To give another example, co-pending claim 10 recites a laminate formulation while pending claim 20 recites a barrier coat composition. The compositions cited by the respective claims vary in several respects. To further illustrate, co-pending claim 35 recites a lay up method that doesn’t correspond to any of the pending claims. Finally, co-pending claim 37 recites a body panel in which glass fibers are greater than 12mm in length, while pending claim 1 recites a body panel wherein reinforcing fibers have a length of 1mm or less.

Because of all of the differences between the co-pending and pending claims discussed above, Applicants respectfully submit the claims are not to the same invention and respectfully request the rejection under 35 U.S.C. § 101 be withdrawn. Applicants reserve the right to further amend, cancel, or file terminal disclaimers with respect to these and other claims as necessary to overcome future rejections.

Claim 37 is provisionally rejected under the judicially created Doctrine of Obviousness type double patenting over claims 7 and 1 of co-pending 10/601,250 (Docket No. H-205868, 8540R-000002). Applicants respectfully traverse the rejection and request reconsideration.

Pending claim 37 recites a barrier coat containing a polyester resin and having glass fibers shorter than the fibers in the fiber reinforced laminate. This limitation is

completely missing from co-pending claims 1 and 7. Further, there is no motivation to modify the co-pending claims to arrive at the subject matter of pending claim 37. For this reason, Applicants respectfully submit that pending claim 37 is non-obvious over co-pending claims 1 and 7. Accordingly, Applicants respectfully request the obviousness type double patenting rejection be withdrawn.

#### **DOUBLE PATENTING OVER CO-PENDING 10/623,922**

Claims 40, 45, and 11 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as claims 10-12 and 18 of co-pending Application 10/623,922 (Docket H-302786, 8540R-000004). Applicants respectfully traverse the rejection and request reconsideration.

For reasons similar to those discussed above with respect to co-pending 10/601,250; Applicants respectfully submit that the pending claims 45, 44 and 11 do not claim the same invention as co-pending claims 10-12 and 18. For example, co-pending claim 18 recites a body panel with different features than the pending claims. Pending claim 1 recites a barrier coat containing a polyester resin, which is not present in the co-pending claims. Finally, co-pending claim 18 does not recite a polyester resin as required in the pending claims. For at least these reasons, the pending claims do not claim the same subject matter.

#### **REJECTION UNDER 35 U.S.C. § 102**

Claims 30-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by the Okayama reference (JP 2001-150559). The rejection corresponds to renumbered

claims 28-34. Applicants respectfully traverse the rejection and request reconsideration.

The patent statute permits recitation of structure in method claims. The mere inclusion of structure in a method claim does not of itself render the claim unstatutory. That is, structural limitations can distinguish methods from the disclosure of a reference. To be entitled to patentable method claims, the recited structural limitations must affect the method in a manipulative sense and not amount to the mere claiming of the use of a particular structure. In re Pfeiffer.

The Examiner has applied In re Pfeiffer to reject the current claims as anticipated over the Okayama reference. The Examiner apparently takes the position that the current claims merely recite the method of use of an article and that therefore the structural limitations of the method claims do not have patentable weight. Applicant respectfully submits that the rule of In re Pfeiffer is not applicable to the current case. In contrast to Pfeiffer, where the method claims at issue were methods for using a patented bag, the current claims are drawn to methods of manufacturing a (patentable) composition. The method recites structural limitations that lead to novelty in the composition. As such, the structural limitations of the current claims are necessarily “manipulatively distinct”. That is to say, methods for producing a novel composition are manipulatively distinct in that the claimed process steps must include the extra steps of providing or adding the components that are the point of novelty. For these reasons, Applicant respectfully submits In re Pfeiffer is not applicable to the current claims and requests the anticipation rejection be withdrawn.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 37-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Okayama reference in view of the GB Patent 1 493 547. These correspond to renumbered claims 35-43. Applicants respectfully traverse the rejection and request reconsideration.

The Okayama reference does not anticipate claims 30-36, as developed above. Applicants respectfully submit that the GB Patent does not make up for the deficiencies of the Okayama reference with respect to claims 37-45. Accordingly, Applicants respectfully request the rejection be withdrawn.

Claims 11, 15, 19, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the GB Patent 1 493 547. Applicants respectfully traverse the rejection and request reconsideration.

Contrary to the statement in the Office Action, the GB patent does not teach a composition with a gel coat, a laminate layer, and a barrier coat disposed therebetween. Rather, the disclosure of the GB patent is drawn exclusively to making sheet molding compound wherein glass rovings are wetted by a resin and deposited on a substrate. The reference is silent about a barrier coat and a gel coat. Because the gel coat and barrier coat are completely missing from the reference, it would not have been obvious to modify the reference to provide them as recited in claims 11, 15, and 19. Applicants respectfully submit the claims are not obvious over the reference. Accordingly, Applicants respectfully request the rejection be withdrawn.

Claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the GB patent and further in view of the Maker reference (U.S. Patent 5,087,405). Applicants respectfully traverse the rejection and request reconsideration.

The deficiencies of the GB patent are discussed directly above. Applicants respectfully submit the Maker reference does not make up for those deficiencies. Accordingly, Applicants respectfully request the rejection be withdrawn.

#### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1-10 are rejected under 35 U.S.C. § 112 as indefinite. Applicant has amended claim 1 to recite “a first set of fibers” and “a second set of fibers” as suggested by the Examiner. Applicants respectfully submit that the meaning and scope of the amended claims is the same as that of the original claims, any amendment being added solely for the purpose of clarification. Applicants respectfully request the rejection as applied to the amended claims be withdrawn.

Claims 20-27 are rejected as indefinite. In response, Applicants have amended claim 20 to recite that the reinforcing fiber component is mixed with the resin component, as suggested by the Examiner. The amended claims have the same scope as the original claims, the amendment being made solely for the purpose of clarity. Applicants respectfully request the rejection be withdrawn.

#### **ALLOWABLE SUBJECT MATTER**

Claims 21-27 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 or other rejections of the base claim. Applicants have so amended the

claims, and successfully traverse rejections of the claims over the art, as discussed above. Applicants respectfully submit that the claims continue to contain allowable subject matter and are allowable.

### CONCLUSION

For the reasons discussed above, Applicants believe the claims 1-43 as amended are in a state of allowability and respectfully request an early notice of allowance. The Examiner is invited to contact Applicants' representative at the telephone number below, if that would be helpful in resolving any issue.

Respectfully submitted,

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